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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,002	08/16/2005	Richard Wade	2859-1-001PCT/US	9394

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EXAMINER	
MAZUMDAR, SONYA	
ART UNIT	**PAPER NUMBER**
1791	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/520,002	WADE, RICHARD	
	Examiner	Art Unit	
	Sonya Mazumdar	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's amendment, see page 2 in remarks filed October 22, 2007, with respect to the objection of claim 1, has been fully considered, and the objection has been withdrawn.

2. Applicant's amendments, see page 6 in the remarks filed, with respect to the rejection of claim 6 under 35 USC 112, 2nd paragraph, have been fully considered, but is not persuasive. There is no disclosure of printing disposed on first surfaces of labels thereon in independent claim 1. Therefore, the rejection is maintained.

3. Applicant's arguments with respect to claims 1 through 6 and 8 through 12 have been considered but, in light of amendments made to claim 1, are moot in view of the new grounds of rejection.

4. Due to lack of arguments against the rejection of claims 7, 13, 14, and 15 under 35 USC 103(a), the rejection is deemed appropriate and is maintained.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the printing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 2, 3, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boreali (US 5,573,621) in view of Schumann et al. (WO 00/30963)

Boreali teaches a method of separating linerless, adhesive labels on a single layer label matrix web (17), where labels (11) are disposed at spaced intervals, and the label boundaries are defined in the web by lines of cutting passing through the web leaving the defined label connected to the remainder of the web by catch points. To remove the labels, the web is fed around a guide member (22) which causes the leading edge of each label to protrude out of the plane of the web and the protruding edge forms a means whereby the remainder of the label can be extracted from the web by breaking the catch points (column 3, column 4, lines 12-24; Figures 4 and 5).

Although Boreali teach passing the labels onward in a first direction (18), there is no specific teaching of placing the detached labels directly onto the surface of a product container. Schumann et al. teach a method of applying adhesive labels to products (abstract). Furthermore, claim 1 discloses using an applicator of "the same function and operation as the conventional beak of conventional application machinery" (lines 5 and 6). Thus it would have been obvious to have the adhesive surfaces of the labels contact and adhere to the product, such that the relative movement causes the release of the labels from the web and the remainder material comprises only that of the single web (English translation of Schumann - US 6,571,983: column 1, lines 4-8; column 3, lines 34-56).

With respect to claim 2, Boreali in view of Schumann et al. teach leading edges of labels to be sufficiently devoid of holding points to ensure that it will reliably protrude from a matrix web (17) when it passes around the guide (22) (Boreali: Figure 5).

With respect to claims 3 and 8, Boreali in view of Schumann et al. teach applying labels which self-adhesive (Boreali: abstract).

With respect to claim 6, Boreali in view of Schmann et al. teach labels with a first surface, opposite the adhesive surface, to act as a release material (Boreali: column 3, lines 44-51).

9. Claims 5, 10, 11, and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Boreali in view of Schumann et al. as applied to claims 1 and 2 above, and further in view of Jeffries (US 3,880,692).

The teachings of claims 1 and 2 are as described above.

Although Boreali in view of Schumann et al. teach labels to have an adhesive surface (Boreali: abstract), there is no specific teaching of applying adhesive to labels on a single-layer web. However, Jeffries teach applying adhesive to a single layer-web of labels, in which the labels are further detached from the web (column 6, lines 6-52; Figures 5, 6, and 7). Thus, it would have been obvious to apply adhesive to labels before being detached from a web to prevent adhesive accumulation in the apparatus (abstract).

10. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boreali in view of Schumann et al. as applied to claims 1 and 2 above, and further in view of West et al. (US 5,275,678)

The teachings of claims 1 and 2 are as described above.

Boreali in view of Schumann et al. do not teach a water application station to wet adhesive on a label prior to application product containers. However, West et al. teach applying water via a water application means (17) to labels (15) with adhesive glue strips (20) prior to applying the labels onto containers (18) (column 5, lines 66 – column 6, line 5; Figures 1 and 2). It would have been obvious to apply water onto an adhesive portion of the label as West et al. taught and would have been motivated to do so to prevent adhesive accumulation in an apparatus and residue on a container's surface (column 4, lines 51-60).

11. Claims 7, 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumann et al. in view Osaka (US 6,030,482).

Schumann et al. teach self-adhesive labels on a web to be applied to products (abstract). Labels (202) are spaced out on a single web (201) where the label contours (203) are defined in a web by lines of cutting and holding points (205) (Figure 2).

Schumann et al. do not teach providing labels with silicon applied to a first surface of a label to act as a release material. However, Osaka teaches it would have been obvious to one having ordinary skill in the art to apply a silicone release agent over printing on a label, in a case where the label web is rolled up and surfaces do not stick to each other (column 2, lines 33-38; column 10, lines 43-47).

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sonya Mazumdar

SM

PHILIP C. TUCKER, PH.D.
SUPERVISORY PATENT EXAMINER
ART UNIT 1791